



IN THE U.S. PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of: Virtanen

Confirmation No.: 3837

Serial No.: 09/381,334

Art Unit: 2617

Filed: November 18, 1999

Docket No.: 846A.0017U1US

Examiner: Iqbal, Khawar

Title: RADIO NETWORK ACCESS MECHANISM

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Mail Stop AF

PRE-APPEAL BRIEF REQUEST FOR REVIEW (ARGUMENT SECTION)-5 Pages

Sir:

The following is a concise recitation of the clear errors in the Examiner's rejections in this application.

This paper addresses the Final Office Action dated February 2, 2010, and the Advisory Action dated June 21, 2010, which maintained the rejections set forth in the Advisory Action. Applicant petitions for a three month extension of time in which to submit this Response and thus authorizes the USPTO to charge the extension fee of \$1110 to Deposit Account No. 50-1924. No further petition or fee is believed to be required upon the filing of this paper. However, should the undersigned attorney be mistaken, please consider this as a petition for any extension of time that may be required to maintain the pendency of this Patent Application and charge Deposit Account No. 50-1924 for any required fees.

Claims 1-3, 6-9, 11, 13 and 15-21 are pending in the subject patent application. The text of these claims is as set forth in Applicant's Response to Final Office Action dated June 2, 2010.

In the outstanding Final Office Action, all claims are rejected under 35 USC Section 103(a) as being obvious over Amin et al. (US 2002/0058506, hereinafter "Amin") in view of Forslow (US 2003/0039237, hereinafter "Forslow"). The afore-referenced Advisory Action maintained the rejection set forth in the Final Office Action. Applicant respectfully disagrees.

As noted above, claims 1-3, 6-9, 11, 13 and 15-21 are pending in this application and, of those claims, claims 1, 2, 8, 15, 18, 19 and 20 are independent. The Panel's attention is respectfully directed to pages 1-7 of Applicant's filed Amendment dated June 2, 2010 for the text of these claims. Moreover, the Panel's attention is respectfully directed to the remarks at pages 8-17 of Applicant's filed

Amendment dated June 2, 2010, which are believed to demonstrate a clear error(s) in the Examiner's rejection.

Moreover, for the reasons set forth below, Applicant respectfully asserts that the cited references do not disclose or suggest Applicant's claimed subject matter, whether the references are viewed alone or in any combination. Nor is there any reason to combine and modify the teachings of these references in an attempt to arrive at Applicant's claimed subject matter. Thus, the following enumerated reasons are believed to demonstrate a clear error(s) in the Examiner's rejection.

1. Claim recitation: "wherein the telecommunications system supports a first network and a second network of a different type."

Regarding this feature, the Examiner contends at page 2 of the Final Office Action that "Amin teaches a method of registering a multimode mobile station in a telecommunications system, wherein the telecommunications system comprises a home location register for maintaining mobile subscriber data and supports a first network and a second network different type ..."

Applicant respectfully disagrees. Amin fails to teach or even suggest a first network and second network of a different type.

2. Claim recitation: "the mobile subscriber data comprising address information for accessing the mobile subscriber via the first and the second network of the different type."

The Examiner fails to cite anything against the above feature.

Applicant respectfully points out that address information may be present in telecommunication systems and the address information is typically implemented in the form of IMSI (International Mobile Subscriber Number).

Amin discloses MIN and ESN numbers (see paragraph [0004]), which are examples of address information. However, Amin's MIN/ESN pair does not disclose or suggest, for example, Applicant's recited claim feature of:

"subscriber-specific access parameter, which indicates, independently of the address information, whether the mobile subscriber has access to rights to the first network and/or the second network."

At page 2 of the Final Office Action, the Examiner contends that Amin discloses Applicant's recited feature of:

“the home location register maintaining a subscriber-specific access parameter which indicates, independently of the address information, whether the mobile subscriber has access to rights to the first network and/or the second network.” The Examiner maintains this position in the Advisory Action.

The Examiner thus appears to equate Applicant's claimed subscriber-specific access parameter with Amin's MIN/ESN pair (paragraph [0004], Fig. 2). Applicant respectfully disagrees and notes that paragraphs [0004]-[0005] of Amin disclose:

“... eavesdroppers intercepting legitimate subscriber's wireless telephone sets' Mobile Identification Numbers (MIN) and Electronic Serial Numbers (ESN) pairs ... The intercepted MINs and ESNs pairs are then programmed into an illegal wireless device to enable a fraud perpetrator to initiate roaming wireless calls that are charged to the legitimate subscribers' accounts.”

As the MIN/ESN pairs in Amin are used to initiate calls, it is clear that Amin fails to disclose anything comparable to Applicant's recited features of “the home location register maintaining a subscriber-specific access parameter which indicates, independently of the address information, whether the mobile subscriber has access to rights to the first network and/or the second network” as in, for example, independent claim 1.

In an alternative reading of the Final Office Action, Amin's "profile" may arguably be cited against Applicant's recited features of "subscriber-specific access parameter which indicates, independently of the address information, whether the mobile subscriber has access to rights." The Examiner refers to Fig. 2 and 4 of Amin's "profile" at page 2 of the Advisory Action. However, even if this reading is applied (which Applicant does not admit to be proper), Amin still fails to disclose or suggest, for example, Applicant's recited claim features of “in response to said message for requesting the mobile subscriber data, the home location register sends the mobile subscriber data and also said subscriber-specific access parameter, “as recited in, for example, independent claim 1.

Instead, Amin discloses in paragraphs [0025] - [0028], which were also cited by the Examiner in the Advisory Action, that a home location register may use a profile, but does not send it.

For completion, it is respectfully asserted that Forslow does not cure the above deficiencies. Thus, no combination of Amin and Forslow (the combination of which is not admitted to be proper by Applicant, as further described below) discloses or suggest such recited features of Applicant's independent claims.

3. Claim recitation: "in response to said message for requesting the mobile subscriber data, the home location register sends the mobile subscriber data and also said subscriber-specific access parameter."

The Examiner cites paragraphs [0025] - [0028] of Amin as disclosing the above feature. However, the Office Action fails to specify which element(s) of the four cited paragraphs of Amin is equated by Examiner as disclosing Applicant's "subscriber-specific access parameter." If the Examiner is referring to Amin's "profile" (which is not admitted to be proper by Applicant), it is noted that Amin also fails to disclose or suggest that the home location register sends the "subscriber-specific access parameter" ("profile" in Amin) in response to said message for requesting the mobile subscriber data. Instead, Amin discloses that a home location register performs roaming restrictions itself.

4. Claim recitation: "wherein the network element that requested the mobile subscriber data is operable to use said subscriber-specific access parameter for restricting the location updating of the mobile station only to the first network or to the second network of the different type."

The Examiner cites paragraphs [0025] - [0028] of Amin and Figs 2 and 4 again with no supporting explanation. It is respectfully asserted that the Office Action fails to specify which element of the four cited paragraphs is allegedly equated with Applicant's "subscriber-specific access parameter." Again, if the Office Action is referring to Amin's "profile" (which again is not admitted to be proper by Applicant), it is noted that Amin fails to disclose or suggest that the home location register sends the "subscriber-specific access parameter" ("profile" in Amin) in response to said message for requesting the mobile subscriber data. Instead, Amin discloses that a home location register performs roaming restrictions itself. It is respectfully noted that the Examiner appears to be referring to Amin's "profile" in the Advisory Action regarding these features.

5. Claim recitation: "wherein the first network and the second network are provided by a common operator."

The Examiner cites Forslow, in particular, Fig. 2, reference numerals 35 and 51, and paragraphs [0030], [0050], [0053]-[0054], [0075] and [0099] as disclosing these features.

Applicant respectfully disagrees with the Examiner's analysis. For example, Forslow fails to disclose or suggest, for example, that networks (arguably elements 35 and 51) are provided by a common operator. Forslow uses the word "operator" only once, in paragraph [0016], and it is clear that the context does not relate to Applicant's afore-recited claim elements.

In an alternative reading of the Office Action, it may be argued that Forslow's networks 35 and 51 may be provided by a common operator because only one home location register is shown. In such a reading (which Applicant does not admit to be proper), the Office Action suffers from the deficiency that the two cited references, namely Amin and Forslow, cannot be combined because they are contradictory to each other. For example, Applicant's independent claims recite, in part, that the "first network and the second network are provided by a common operator." In contrast, Amin discloses a home location register maintaining a profile that defines roaming restrictions. By definition, "roaming" means accessing a network other than the subscriber's home network. Those skilled in the art will realize that a subscriber's home network and a roamed network cannot be provided by a common operator. Therefore the two cited references, namely Amin and Forslow, cannot be properly combined and result in any teaching or suggestion of Applicant's claimed invention. The Examiner does not appear to address this teaching away argument in the Advisory Action. In contrast, the Examiner states that the "examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to provide the claimed invention where there is some teaching, suggestion, or motivation to do so ...".

For at least the foregoing reasons, clear error(s) is believed to be present in the outstanding rejection. Accordingly, all independent claims are believed to be patentable in view of the cited art. As all independent claims are patentable, all remaining dependent claims also are patentable at least in view of their dependency from an allowable independent claim.

A favorable consideration that results in allowance of the pending claims is earnestly solicited.

Respectfully submitted:

Christine Wilkes Beninati

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Aug. 2, 2010
Date

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PTO/SB/33 (07-09)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		846.A.0017.U1(US)	
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	09/381,334	Nov. 18, 1999	
	First Named Inventor	Virtanen, Kari	
Art Unit	2617	Examiner	Iqbal, Khawar
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/>	applicant/inventor.		
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number <u>37,967</u>		
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		
		<u>Christine Wilkes Beninati</u> Signature <u>Christine Wilkes Beninati</u> Typed or printed name <u>203-925-9400</u> Telephone number <u>August 2, 2010</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

<input type="checkbox"/>	*Total of _____ forms are submitted.
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